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Filing date: **07/11/2013**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	94002561
Party	Applicant Raimund Trenkler
Correspondence Address	DAVID H BERNSTEIN DEBEVOISE & PLIMPTON LLP 919 3RD AVE NEW YORK, NY 10022-3902 UNITED STATES trademarks@debevoise.com
Submission	Other Motions/Papers
Filer's Name	Kevin Bensley
Filer's e-mail	trademarks@debevoise.com, kbensley@debevoise.com
Signature	/Kevin A. Bensley/
Date	07/11/2013
Attachments	Kronberg Termination Stipulation.pdf(401983 bytes )

RAIMUND TRENKLER,  
Plaintiff,  
  
v.  
  
KRONBERG ENSEMBLE,  
Defendant.


## STIPULATION AND ORDER

IT IS HEREBY STIPULATED AND AGREED, by and among the undersigned counsel for the parties below, that by letter agreement between the parties dated May 6, 2013 (the “Agreement”) the Defendant has assigned to the Plaintiff its entire right, title and interest in and to the mark which is the subject of this concurrent use proceeding, together with the goodwill of the business associated therewith, and that the Defendant has further agreed to adopt a new business name and to not use such mark in the future (subject to certain limited licensed uses as described in the Agreement). The Agreement is attached as Exhibit A hereto. The parties hereby request that, upon entry of this Stipulation and Order, the Board delete the concurrent use restriction from Plaintiff’s application for registration (Serial No. 85628503) and terminate this concurrent use proceeding.

Dated: July 11, 2013  
New York, New York

DEBEVOISE & PLIMPTON LLP  
919 Third Avenue  
New York, New York 10022  
(212) 909-6000

By:

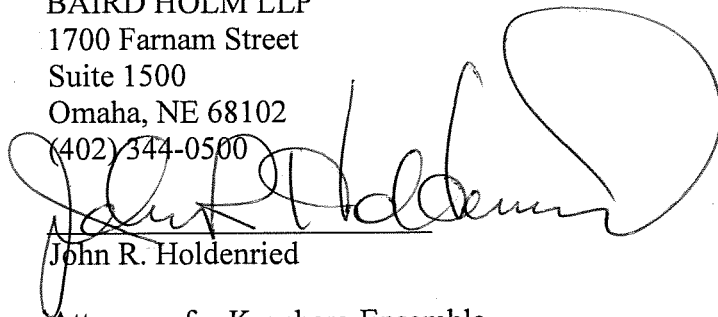
  
Kevin A. Bensley

Attorneys for Plaintiff Raimund Trenkler's  
related company Kronberg Academy

Dated: July 11, 2013  
Omaha, NE

BAIRD HOLM LLP  
1700 Farnam Street  
Suite 1500  
Omaha, NE 68102  
(402) 344-0500

By:

  
John R. Holdenried

Attorneys for Kronberg Ensemble

SO ORDERED:

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Trademark Trial and Appeal Board

Exhibit A  
Agreement

May 6, 2013

The Kronberg Ensemble  
P.O. Box 24059  
Omaha, NE 68124  
Attention: Sophia Potter, President

Ladies and Gentlemen:

Kronberg Academy (the "Academy") is a well-known musical academy based in Kronberg, Germany, which has served the international music community since 1993. The Academy has used the name "Kronberg Academy" in the United States since 2005. While preparing an application to register the mark "Kronberg Academy" with the United States Patent and Trademark Office, the Academy discovered the existence of the Kronberg Ensemble (the "Ensemble"), a string chamber ensemble operating in the State of Nebraska since November 2011. The Academy filed its application for registration on a concurrent use basis on May 17, 2012, and a concurrent use proceeding is currently pending before the Trademark Trial and Appeal Board (the "TTAB").

The Ensemble has informed the Academy that, as an alternative to determining its and the Academy's respective rights to the "Kronberg" mark through a concurrent use proceeding before the TTAB, the Ensemble has decided to undergo a change of name and assign any and all rights it may have to the "Kronberg" mark to the Academy (the "Name Change"). The Academy, in turn, has offered to reimburse the Ensemble for certain expenses that the Ensemble has incurred in the process of the Name Change.

Accordingly, subject to the terms and conditions set forth below, the Academy agrees with the Ensemble as follows:

1. Name Change and Assignment of Rights. The Ensemble hereby agrees that, within ten days after the date of this letter agreement, the Ensemble will cease all use of the name "Kronberg Ensemble" and the word "Kronberg" (including, but not limited to, uses of the name "Kronberg Ensemble" and the word "Kronberg" in connection with musical performances, advertising, social media and merchandise), other than as described in Sections 3, 4, and 5 of this letter agreement. Subject to such sections, the Ensemble does hereby assign, set over and transfer to the Academy, its successors and assigns, the entire right, title and interest in and to the "Kronberg" mark, together with the goodwill of the business associated therewith and all applications or registrations therefor.

2. Domain Names and Social Network Pages. The Ensemble hereby assigns, sets over and transfers to the Academy, its successors and assigns any and all domain name registrations it currently owns which contain the word “Kronberg” or any derivative thereof, including, but not limited to, the registration for www.kronbergensemble.org. The Ensemble hereby agrees to cease use of all domain names and social network pages bearing the “Kronberg” mark or any derivative thereof, other than as provided for in Sections 3 and 4 of this letter agreement.

3. License Through May 29, 2013. The Academy hereby grants the Ensemble a limited, non-exclusive, non-transferrable, royalty-free, fully paid-up license, without the right to sub-license, to use the “Kronberg” mark solely for the purpose of advertising for concerts which the Ensemble is scheduled to perform on or before May 29, 2013. At all times, the Ensemble shall use the “Kronberg” mark pursuant to the license granted in this Section 3 only in accordance with such quality standards and specifications as may be reasonably established by the Academy and communicated to the Ensemble from time to time. The license granted pursuant to this Section 3 shall expire on May 29, 2013.

4. Transition Period License for Emails. The Academy hereby grants the Ensemble a limited, non-exclusive, non-transferrable, royalty-free, fully paid-up license, without the right to sub-license, to use the “Kronberg” mark solely to the extent necessary for providing notification via automatic response to persons who send an email to kronbergensemble@gmail.com that the Ensemble is no longer reachable at such address. At all times, the Ensemble shall use the “Kronberg” mark pursuant to the license granted in this Section 4 only in accordance with such reasonable quality standards and specifications as may be established by the Academy and communicated to the Ensemble from time to time. The license granted pursuant to this Section 4 shall expire on November 29, 2013.

5. Destruction or Donation of Existing Merchandise and Materials. The Ensemble hereby agrees to cease all sale and use of merchandise and other materials bearing the “Kronberg” mark, including, but not limited to, t-shirts, mugs, checks, brochures, programs, pamphlets, posters and other publicity materials (collectively, the “Merchandise”) no later than May 29, 2013. The Ensemble hereby further agrees to either destroy or donate to a charity of its choosing, in each case no later than June 30, 2013, all Merchandise still in its possession. As soon as reasonably practicable after the destruction or donation of such Merchandise pursuant to this Section 5, the Ensemble shall provide to the Academy a certification, signed by its Board President, that the sale and use of such Merchandise was ceased and that such Merchandise has been so destroyed or so donated, in each case pursuant to this Section 5.

Notwithstanding the above, the Academy agrees that the Ensemble may continue to use media articles (radio, television, newspaper) that refer to The Kronberg Ensemble as publicity materials in promoting its future performances and fundraising, so long as the

Ensemble includes a statement with any use of such media articles setting out its new name and disclaiming any affiliation with the Academy and so long as it uses such media articles only for reference to past activities under its prior name.

6. Reimbursement of Expenses. The Academy hereby agrees to pay to the Ensemble, as reimbursement for certain expenses incurred by the Ensemble in the process of the Name Change, the sum of \$763 as soon as reasonably practicable following the date of this letter agreement. It is understood by the parties that such sum does not necessarily reflect the total expense incurred by the Ensemble in the process of the Name Change and that nothing contained in this letter agreement shall create an obligation on the part of the Academy to provide any additional reimbursement amounts to the Ensemble.

7. Termination. This letter agreement and the obligations of the parties hereunder shall continue in full force and effect unless terminated by an instrument in writing signed on behalf of each of the parties hereto.

8. Release by the Academy. In consideration of the obligations of the Ensemble set out in this letter agreement and conditioned upon the fulfillment of all such obligations, the Academy hereby releases and discharges the Ensemble and its officers, directors, and agents from any and all claims, demands, and causes of action which the Academy may have against the Ensemble, whether presently known or unknown, asserted or unasserted, arising out of or related to the use by the Ensemble of the Kronberg mark or name.

9. Release by the Ensemble. In consideration of the obligations of the Academy set out in this letter agreement and conditioned upon the fulfillment of all such obligations, the Ensemble hereby releases and discharges the Academy and its officers, directors, and agents from any and all claims, demands, and causes of action which the Ensemble may have against the Academy, whether presently known or unknown, asserted or unasserted, arising out of or related to the use by the Academy of the Kronberg mark or name.

10. No Admission. This Agreement is a mutually agreed upon compromise of matters related to the use by the Ensemble of the Kronberg mark and name and any disputes between the parties related thereto, and shall not be treated as an admission of liability or fault by any party for any purpose.

11. Attorney Fees and Costs. Each party shall pay their own attorney fees in connection with negotiation and resolution of this letter agreement and be responsible for its own costs in carrying out its obligations under this letter agreement.

12. Dispute Resolution. Any dispute, controversy or claim arising out of, related to, or in connection with this letter agreement or the breach, termination or validity thereof (a “Dispute”), shall be settled only in accordance with the procedures set forth in this Section 12. In the event mediation is terminated, the Dispute shall be submitted to, and settled only by, arbitration conducted in accordance with the then-current CPR Fast Track Arbitration Rules, except as they may be modified herein or by mutual agreement of the parties. The arbitration shall be held in the County of New York in the State of New York. The arbitration shall be conducted by a sole arbitrator selected from the INTA Panel of Neutrals. The arbitrator shall be authorized to award such injunctive and monetary relief as he or she believes appropriate. The arbitrator shall award attorneys’ fees, costs and disbursements to the prevailing party (including all fees, costs and disbursements incurred in connection with any earlier mediation), and the losing party shall bear the arbitrator’s fees and disbursements. The arbitral award shall be in writing, state the reasons for the award, and be final and binding on the parties. The arbitration shall be governed by the United States Arbitration Act, 9 U.S.C. §§ 1-16, and judgment upon the award may be entered by any court having jurisdiction over the relevant party or parties. For purposes of enforcement of any such award, the parties agree to submit to the jurisdiction of the state and federal courts located in the County of New York in the State of New York (the “Court”). Notwithstanding the foregoing, while the arbitration is pending, either party may apply to the Court for provisional relief if, in that party’s judgment, such an action is necessary to preserve the status quo.

12. Miscellaneous.

(a) Notices. All notices, requests, claims, demands and other communications hereunder shall be in writing and shall be given personally, by facsimile or other electronic image scan transmission (which is confirmed) or sent by overnight courier (providing proof of delivery) to the parties at the following addresses (or at such other address for a party as shall be specified by like notice):

(i) if to the Ensemble, to:

The Kronberg Ensemble  
P.O. Box 24059  
Omaha, NE 68124  
Attention: Board President

with a copy to:

Baird Holm LLP  
1700 Farnam Street, Suite 1500  
Omaha, NE 68102  
Attention: John R. Holdenried

(ii) if to the Academy, to:

Kronberg Academy  
Burgerstrasse 22  
Kronberg, 61476  
Germany  
Attention: Raimund Trenkler

with a copy to:

Debevoise & Plimpton LLP  
919 Third Avenue  
New York, New York 10022  
Attention: Dagmar Tricot  
Kevin Bensley

Notices shall be deemed given upon receipt.

(b) Amendment; Waiver. This letter agreement may not be amended except by an instrument in writing signed on behalf of each of the parties hereto. Any agreement on the part of a party to extend the time for the performance of any of the obligations or other acts of the other parties hereunder or to waive compliance with any of the agreements or conditions contained herein shall be valid only if set forth in an instrument in writing signed on behalf of such party. The failure of any party to this letter agreement to assert any of its rights under this letter agreement or otherwise shall not constitute a waiver of such rights nor shall any single or partial exercise by any party to this letter agreement of any of its rights under this letter agreement preclude any other or further exercise of such rights or any other rights under this letter agreement.

(c) Interpretation. The headings contained in this letter agreement are for reference purposes only and shall not affect in any way the meaning or interpretation of this letter agreement. Whenever the words “include”, “includes” or “including” are used in this letter agreement, they shall be deemed to be followed by the words “without limitation”. The words “hereof”, “herein” and “hereunder” and words of similar import when used in this letter agreement shall refer to this letter agreement as a whole and not to any particular provision of this letter agreement. The word “will” shall be construed to have the same meaning and effect as the word “shall”. The word “extent” in the phrase “to the extent” shall mean the degree to which a subject or other thing extends, and such phrase shall not mean simply “if”. All terms defined in this letter agreement shall have the defined meanings when used in any certificate or other document made or delivered pursuant hereto unless otherwise defined therein. References to a person are also to its permitted successors and assigns. This letter agreement is the product of negotiation by the parties having the assistance of counsel and other advisers. It is the intention of the

parties that this letter agreement not be construed more strictly with regard to one party than with regard to the others.

(d) Counterparts. This letter agreement may be executed in two or more counterparts, all of which shall be considered one and the same agreement and shall become effective when one or more counterparts have been signed by each of the parties and delivered to the other parties (including by facsimile or other electronic image scan transmission).

(e) Governing Law. THIS LETTER AGREEMENT OR ANY CLAIMS ARISING UNDER OR RELATING TO THIS LETTER AGREEMENT SHALL BE GOVERNED BY, AND CONSTRUED IN ACCORDANCE WITH, THE LAWS OF THE STATE OF NEW YORK REGARDLESS OF THE LAWS THAT MIGHT OTHERWISE GOVERN UNDER APPLICABLE PRINCIPLES OF CONFLICTS OF LAWS.

(f) Severability. If any term or other provision of this letter agreement is invalid, illegal or incapable of being enforced by any rule of law or public policy, all other conditions and provisions of this letter agreement shall nevertheless remain in full force and effect. Upon such determination that any term or other provision is invalid, illegal or incapable of being enforced, the parties hereto shall negotiate in good faith to modify this letter agreement so as to effect the original intent of the parties as closely as possible to the fullest extent permitted by applicable law in an acceptable manner to the end that the transactions contemplated by this letter agreement are fulfilled to the extent possible.

(g) Further Assurances. The parties agree to execute all such further instruments and documents and to take all such further action as the other party may reasonably require in order to effectuate the terms and purposes of this letter agreement. The parties shall act in good faith in the performance of their obligations under this letter agreement.

(h) Assignment. Neither party shall be permitted to assign this letter agreement in whole or in part without the prior written consent of the other party, except that the Academy may assign this letter agreement in whole or in part to any affiliate of the Academy without the consent of the Ensemble.

*[Remainder of this page intentionally left blank]*

Please execute this letter agreement in the space provided below to acknowledge your acceptance of and agreement to the provisions hereof.

Sincerely,

**KRONBERG ACADEMY**

By: 

Name: Raimund Trenkler

Title: Managing Director

3. Mai 2013

Accepted and agreed to  
as of the date first above written

**THE KRONBERG ENSEMBLE**

By: \_\_\_\_\_

Name: Sophia Potter

Title: Board President

Please execute this letter agreement in the space provided below to acknowledge your acceptance of and agreement to the provisions hereof.

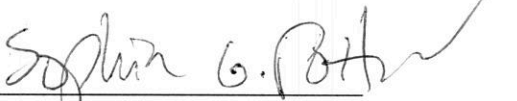
Sincerely,

**KRONBERG ACADEMY**

By: \_\_\_\_\_  
Name: Raimund Trenkler  
Title: Managing Director

Accepted and agreed to  
as of the date first above written

**THE KRONBERG ENSEMBLE**

By:  \_\_\_\_\_  
Name: Sophia Potter  
Title: Board President